

REMARKS

This Amendment is responsive to the Final Office Action mailed May 28, 2008, and the Advisory Action mailed October 7, 2008. Entry of this paper and reconsideration of the subject application in view thereof are respectfully requested.

I. Status of Claims

Claim 11 is pending in this application. This claim stood rejected.

II. Response to the Advisory Action

In the Advisory Action, the Examiner noted that “[t]he rejection of claim 11 is maintained for reasons of record. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Chenchik et al.”

Applicant respectfully believes that the claim rejection made in the Final Office Action of May 28, 2008 and maintained in the Advisory Action have been overcome in view of the following discussion.

A. Examiner failed to establish a prima facie case of anticipation

Identity of invention requires that a prior reference necessarily [not fairly] disclose to one of ordinary skill in the art all elements and limitations of the patent claim. Absence from the reference of any claimed element negates anticipation. The Examiner failed to meet the burden required for establishing anticipation.

The Examiner’s mischaracterization of both the Chenchik reference and Applicant’s arguments, and not answering the substance of the Applicant’s arguments in an attempt to establish and maintain the anticipation rejection are in violation of the Patent Examining Procedure and the case law.

In the Final Office Action, the Examiner pointed to Chenchik page 9, lines 24-29 and to show that this text “reads on multiple oligonucleotides that are only biological stress related genes.” But what claim 11 requires is “an array of multiple oligonucleotides . . . wherein said oligonucleotides are only biological stress related genes . . .” What the Examiner must show is where this limitation can be found in Chenchik. Chenchik at page 9, lines 24-29, states the following:

Therefore, the arrays of the subject invention will be of a specific array type, where representative array types include: human arrays, mouse arrays, cancer arrays, apoptosis arrays, human stress arrays, oncogene and tumor suppressor arrays, cell-cell interaction arrays, cytokine and cytokine receptor arrays, rat arrays, blood arrays, mouse stress arrays, neuroarrays, and the like, where some of these representative arrays are described in greater detail below.

For example, Chenchik at page 10, lines 20-30 further clarifies what “the arrays of the subject invention will be of a specific array type” means (reproduced below):

As mentioned above, the subject arrays typically comprise one or more additional spots of polynucleotides which do not correspond to the array type, i.e. the type or kind of gene represented on the array. In other words, the array may comprise one or more spots that are made of non "unique" polynucleotides, i.e. common polynucleotides. For example, spots comprising genomic DNA may be provided in the array, where such spots may serve as orientation marks. Spots comprising plasmid and bacteriophage genes, genes from the same or another species which are not expressed and do not cross hybridize with the cDNA target, and the like, may be present and serve as negative controls. In addition, spots comprising housekeeping genes and other control genes from the same or another species may be present, which spots serve in the normalization of mRNA abundance and standardization of hybridization signal intensity in the sample assayed with the array.

The Chenchik reference generically refers to “human stress arrays” in the text above and provides specifics starting at page 87, line 1 through page 102, line 35, including Table 5 with a listing of genes. Consistent with the above quoted text from the Chenchik reference, this array has housekeeping genes and negative controls (see page 102). Thus, the array disclosed in Chenchik is NOT “an array of multiple oligonucleotides . . . wherein said oligonucleotides are only biological stress related genes . . .”

Applicant in its response to the Final Office Action of May 28, 2008, pointed to these teachings and submitted that “Chenchik fails to teach each and every limitation of claim 11, either expressly or inherently, which teaching is required for the reference to anticipate the claimed invention.” In the Advisory Action, however, the Examiner chose to allege that Applicant “does not . . . identify any specific features lacking in the prior art.”

In the Final Office Action, with regard to the claim 11 recitation that “the specific classification is (1) . . . and (9) . . . ,” the Examiner simply referred to

Table 5, which starts at page 88 and ends at page 102 of the Chenchik reference. The Examiner did not point to page and line number in Chenchik for each of the genes (1)-(9) as set forth in lines 7-14 of claim 11 showing that Chenchik necessarily teaches the genes. The Examiner must point to where Chenchik teaches each of (1) . . . (9) so that Applicant can respond in the form of arguments and/or claim amendments to advance prosecution of the patent application. A conclusory assertion that for “(1)-(9),” “see Table 5 of Chenchik et al.” is not sufficient. As admitted by the Examiner, it is possible that “Table 5 . . . fairly reads on the classification of gene functions (1)-(9) as set forth in lines 7-14 of claim 11 . . .” For a prior art reference to anticipate, however, it must “necessarily,” not merely “fairly” read on each and every element of the claimed invention. If such facts are within the Examiner's personal knowledge, the Examiner is requested to make them part of the record by way of affidavit as required by 37 C.F.R. §1.104(d)(2). This is the burden the Examiner must meet and has not met so far. Applicant made these requests in its response to the Final Office Action of May 28, 2008 as well. In the Advisory Action, however, the Examiner chose to allege that Applicant “does not . . . identify any specific features lacking in the prior art.”

Furthermore, according to the Patent Examining Procedure, where the applicant traverses any rejection, as in the instant case, the Examiner should take note of the applicant's argument and answer the substance of it. See MPEP § 707.07(f).

B. Rejection under 35 U.S.C. §112, second paragraph - clarification regarding “comprising an array of multiple oligonucleotides . . . are only biological stress related genes or complementary sequences to said genes” recited in claim 11

In the office action mailed May 2, 2007, the Examiner rejected claim 11 citing the Chenchik reference under the same grounds after construing that “only biological stress related genes or complementary sequences to said genes are fixed onto a substrate.” In that office action, the Examiner also suggested that the claim recite “--consisting of--” in place of “comprising.” In the Final Office Action, at pages 2-3, the Examiner revisited this issue as follows:

“Applicants argument that the phrase ‘comprising’ in line 1 of the instant claim is intended to be open-ended such that the claimed

array may comprise additional, unrecited elements is acknowledged. In light of this, the instantly claimed oligonucleotide array 'comprising' an array of multiple oligonucleotides has been construed to be open to further comprising additional sequences other than the multiple oligonucleotides recited in the instant claims."

Applicant respectfully submits herewith as follows:

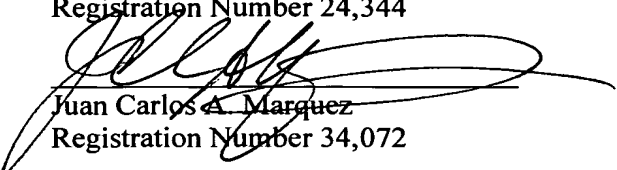
Applicant agrees with the Examiner to the extent the claim has been construed to "open to" "additional sequences" (e.g., fluorescent dyes or labels) other than multiple oligonucleotides. To the extent claim 11 has been construed to "open to" additional multiple oligonucleotides" Applicant submits that both the claim language and the Applicant's remarks against the Chenchik reference make clear that only biological stress related genes or complementary sequences to said genes (i.e., multiple oligonucleotides **consist of** biological stress related genes or complementary sequences to said genes) are fixed onto a substrate. The unrecited and non-multiple oligonucleotide elements (e.g., fluorescent dyes or labels) are not excluded. Applicant respectfully reminds again that breadth of a claim is not to be equated with indefiniteness. The scope of the subject matter embraced by the claim is clear and the Applicant has not otherwise indicated that it intends the invention to be of a scope different from that defined in the claims.

The Examiner's suggestion in the Office Action of May 2, 2007 that the claim recite "--consisting of--" in place of "comprising" would preclude a construction to include such unrecited and non-multiple oligonucleotide elements described in detail in the specification. One of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. The statute is satisfied if a person skilled in the field of the invention would reasonably understand the claim when read in light of the specification. The

§ 112, second paragraph, demands no more. Thus, claim 11 reciting the transitional phrase “comprising,” is not indefinite .

Respectfully submitted,

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